

REMARKS

This Application has been carefully reviewed in light of the Office Action. Claims 1-29 are pending in the Application. For at least the reasons provided below, Applicants respectfully request reconsideration and favorable action in this case.

Allowed Claims

Applicants note with appreciation the Examiner's indication that Claims 1-29 are allowed.

Drawing Objections

The Office Action objects to the drawings under 37 C.F.R. 1.83(a), stating that the drawings must show every feature of the invention specified in the claims. Applicants submit the attached corrected drawing sheet adding Figure 2E. Applicants attach to this Response the Replacement Sheet including added Figure 2E. Applicants respectfully request approval and entry of the replacement drawing.

In order to describe Figure 2E, Applicants have amended the Specification at Page 5, Lines 13-17, and Page 14, Line 6 - Page 15, Line 2. Support for these amendments can be found at least at Page 16, Lines 2-14; Page 16, Line 30 - Page 17, Line 4; and Page 18, Lines 2-8 of the Specification. Reconsideration and favorable action are requested.

Claim Objections

The Office Action objects to Claims 11-15, 17-24, and 26-28, contending that the limitation "operable to" does not limit the scope of a claim. Applicants respectfully traverse this contention.

With respect to Claim 11, Applicants respectfully submit that the phrase "a plurality of switches each connected to a least one other switch in the stackable switch system, each switch comprising a stack manager operable to: receive a communication from a second switch in the in the stackable switch system; determine, based on the communicated message, that the switch in the stackable switch system has the same switch number as the second switch; and in response to the determination that the switch and the second have the same switch number, determine whether the switch should keep the switch number or select a new switch number" of Claim 11 does in fact limit the scope of the claim. The law is clear that

“[t]here is nothing inherently wrong with defining some part of an invention in functional terms. Functional language does not, in and of itself, render a claim improper.” *In re Swinehart*, 169 USPQ 226 (CCPA 1971); *MPEP* § 2173.05(g). If functional language defines one or more structural attributes of an element, then the Examiner must give that language patentable weight.¹ A system element described as “operable to” perform certain functions covers operations that the element **is capable** of performing, and not just operations that the elements **may be capable** of performing. Applicants note that the ordinary dictionary definition of “operable” is “practicable.” *Webster’s II New College Dictionary* 227 (2001). The dictionary definition of “practicable” is “capable of being done.” Thus, as stated above, elements following the term “operable to” in a particular claim element constitute operations that the claim element is capable of performing. Operations that a claim element is capable of performing are limitations, because the element is thus distinguished from the prior art that is incapable of performing the operations.

Applicants further note that “operable to” is a commonly used term in patent application claims, particularly in computer-implemented inventions, and is present in claims of numerous patents issued by the United States Patent and Trademark Office. A search in the claims field of the United States Patents Database (as of June 26, 2007) produced well over 150,000 issued patents that include the phrase “operable to” in the claims.

For at least these reasons, Applicants respectfully request allowance of Claim 11. For analogous reasons, Applicants respectfully request allowance of Claims 12-15, 17-24, and 26-28. Reconsideration and favorable action are requested.

¹ See e.g., *MPEP* §2173.05(g) (stating that “a chemical compound that is incapable of forming a dye,” “members adapted to be positioned,” and “portions. . . being resiliently dilatable whereby said housing may be slidably positioned” serve[d] to precisely define present structural attributes of interrelated component parts of the claims assembly.)

CONCLUSION

Applicants have made an earnest attempt to place this case in condition for allowance. For at least the foregoing reasons, Applicants respectfully request full allowance of all the pending claims.

If the Examiner believes a telephone conference would advance prosecution of this case in any way, the Examiner is invited to contact Keiko Ichiye, the Attorney for Applicants, at the Examiner's convenience at (214) 953-6494.

Although Applicants believe no fees are due, the Commissioner is hereby authorized to charge any fees or credit any overpayments to Deposit Account No. 02-0384 of Baker Botts L.L.P.

Respectfully submitted,

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